

Remarks

Failure to comply with the Rules of Practice

The official action is objected to because the Examiner has failed to comply with the Rules of Practice and in particular violates 37 CFR 1.104. 37 CFR 1.104 sets forth the nature of examination and the requirements that the Examiner must follow in examining a patent application. 37 CFR 1.104(c)(2) recites

“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”

Note the obligation upon the Examiner to designate, as nearly as practicable, the particular point relied upon in a cited reference.

In rejecting claims 1 and 14 in this application, the Examiner fails to point out where in the Cisneros document claims 1 and 14 are allegedly anticipated by Cisneros. As such, the Examiner’s action in rejecting the claims in this application based upon Cisneros does not comply with the Rules of Practice.

The Examiner is respectfully requested to withdraw the official action and issue a new official action fully complying with the Rules of Practice.

The rejection under 35 U.S.C. 102

The Examiner rejects claims 1 and 14 under 35 U.S.C. 102.

The Applicant does not understand where the limitations of these claims are allegedly found in Cisneros.

The Examiner asserts in the official action that Cisneros teaches a method comprising, inter alia, "adaptively varying the interval between location updates from said first source independence on the provision of location data indicative of the current location of the mobile entity from at least one other source of location data that operates independently of said first source and the location updates provided thereby."

Based upon the Examiner's assertion, one would think that the word "adaptively" would appear somewhere in Cisneros. However, the undersigned has done a search of the Cisneros document as available on the Internet for the root of that word, namely "adapt" and was not able to find either the word "adapt", "adapted", "adaptive", or "adaptively." As such, just what portion of the disclosure of Cisneros is the Examiner relying upon in supposedly teaching the technology recited above?

The Examiner also uses the word "varying" in making the rejection. However, other than in the discussion of the prior art in Cisneros, where does Cisneros use the word "vary" or "varying"?

Additionally, the Examiner's attention is directed to the paragraph bridging columns 21 and 22 of Cisneros wherein Cisneros teaches that in the preferred embodiment, the global unit's position is typically recomputed about every 0.5 seconds. That hardly sounds like "the interval between updates being adaptively varied in dependence upon the provision of location data about the mobile entity from at least one other source of location data" as specifically claimed by claim 1.

Since the Examiner has failed to point out how Cisneros teaches each and every limitation of rejected claims 1 and 14, the rejection under 35 U.S.C. 102 is improper and should be withdrawn.

The rejections under 35 U.S.C. 103

MPEP 2142 sets forth the legal concept of prima facie obviousness and sets forth the obligations of the Examiner in establishing a case of prima facie obviousness.

If the Examiner fails to set forth a prima facie case of obviousness, then the Applicant is under no obligation to submit evidence of non-obviousness.

In this case, the Examiner has failed to establish a prima facie case of obviousness. Paraphrasing the MPEP, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success, and finally, the prior art reference(s) must teach or suggest all of the claim limitations.

The simple fact that two references are from "the same field of endeavor" does not make an invention prima facie obvious.

Furthermore, even if it were somehow obvious to somehow combine the teachings of Cisneros and Taft, the Examiner has not pointed out how each and every limitation of claim 2 would then be allegedly taught by the teachings of those two references. In making the rejection, the Examiner talks about "short range location beacons" but does not mention the other limitations of claim 2, for example. Limitations cannot be simply ignored when making a prior art based rejection.

With respect to the rejections of the remaining dependent claims, the Applicant notes that the Examiner has failed to point out what would be the alleged motivation for combining Taft and Cisneros.

Also, the Examiner's citation of paragraphs 1, 2, 4 and 5 on page 4 of Taft is very telling.

As the MPEP points out, the Examiner must avoid the tendency to resort to "hindsight" based upon Applicant's disclosure. The Examiner's rejection is telling in that the Examiner skips over paragraph 3 on page 4 of Taft. However, a person of ordinary skill in the art who is familiar with Cisneros and who is familiar with Taft, but who is not familiar with Applicant's invention, would not know, in advance, that their eyes should

skip over the words in paragraph 3 and jump from paragraph 2 to paragraph 4. It is submitted that the only reason that the Examiner skips over paragraph 3, is that the words of paragraph 3 are rather inconvenient for the Examiner in terms of making the rejection and therefore the Examiner ignores those words. However, a person of ordinary skill in the art who has not had the privilege of reading the Applicant's patent application, does not know that they should skip over those words.

The Examiner also rejects claims 3-5, 8-11 and 16-18 under 35 U.S.C. 103 as allegedly being unpatentable over Cisneros in view of Mannings.

Again, the Examiner justifies his citation of Mannings merely because it is allegedly "from the same field of endeavor." That is not appropriate justification according to the MPEP. Rather, the Examiner must satisfy the test for making a prima facie case of obviousness as set forth in MPEP section 2142.

Moreover, it is not understood why a person of ordinary skill in the art who is familiar with Cisneros would allegedly turn to Mannings. The Examiner asserts that the reason one would do that was to "provide a more refined position of the mobile station." However, at the point noted by the Examiner in Mannings, Mannings is talking about changing the frequency of updates based upon the speed of a vehicle traveling over urban, rural or motorway environments. However, in Cisneros, Cisneros teaches that the update should be recomputed at approximately every 0.5 seconds, which apparently works even if the mobile unit is operating at a rather high rate of speed, such as 1000km/hour in a airplane. If Cisneros works for mobile units traveling at those speeds, there is hardly any motivation to make it work faster for someone traveling in a comparatively slow moving vehicle, such as the automobile as envisioned by Mannings.

Again, it is submitted that this is evidence that the Examiner is making these rejections based upon a hindsight reconstruction of the claims as opposed to what the references really teach.

Reconsideration of this application is respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents

PO Box 1450, Alexandria, VA 22313-1450 on

May 13, 2005

(Date of Deposit)

Corinda Humphrey

(Name of Person Signing)

(Signature)

May 13, 2005

(Date)

Respectfully submitted,


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